

REMARKS

Claims 1 and 3 stand rejected in the Final Office Action. Applicants have filed a Request for Continued Examination. Applicants have deleted claims 1 and 3 and added claims 4-18. Upon entry of the amendments, claims 4-18 remain pending.

Support for claims 4-8 is found in the specification as filed, for example at page 4, lines 7-11; page 6, lines 11-15; as well as in original claims 1 and 2. Support for claims 9-13 is found in the places mentioned above for claims 4-8, and additionally at page 7, lines 5-8. Support for claims 14-18 are found in the locations cited above, and also at page 4, line 12 – page 5, line 2. Applicants respectfully request entry of the amendments.

Rejections Under 35 U.S.C. § 103 In View of JP 8266261

Claims 1 stands rejected under 35 U.S.C. § 103 as unpatentable over Japanese Patent, JP 8266261 (JP ‘261). Applicants respectfully traverse the rejection as applied to the amended claims and request reconsideration.

For rejection of a claim to be sustained over single reference under § 103, the reference must teach or suggest every limitation of the claim. Furthermore, there must be a motivation for one of skill in the art to modify what the reference disclosed is to arrive at the subject matter of the claims. If the proposed modification would render the subject of the reference unsuitable for its intended use, there is no motivation to modify.

The JP ‘261 reference does not disclose or suggest a cigarette having Ginkgo biloba leaves in the burnable material as laid out in new claims 4 and 9, and in the claims dependent therefrom. In JP ‘261, Ginkgo biloba leaves are listed as one possible component of the filter of

the cigarette. The reference does not disclose or suggest that any Ginkgo leaves are in the burning portion of the cigarette or cigar, as in the amended claims.

The reference and the knowledge of one of skill in the art provide no motivation to modify what JP '261 discloses to arrive at the subject matter of the claims. In the present invention, all of the Ginkgo leaves in the burning material can be burned away and inhaled by a smoker during smoking. In the reference any Ginkgo leaves present in the filter remain in the filter after smoking.

The suggested modification would render the cigarettes of JP '261 unsuitable for their intended use. The reference discloses that the use of Ginkgo leaves or other materials in the filter does not influence the taste of the cigarette too much. By contrast, the cigarettes and cigars of the invention are made up of 50% by weight or more Ginkgo biloba L. leaves, and produce a different smoking experience in the smoker. Were one to modify the reference to include Ginkgo biloba leaves in the smoking material of the cigarette, presumably the taste of the cigarette would be altered. Such modification would make the cigarette of the JP '261 reference less suitable for its intended purpose.

Because the reference provides no motivation to make the modification, and the modification if made would render the subject matter of the reference unsuitable for its intended purpose, Applicants respectfully submit that a *prima facie* case of obviousness over JP '261 cannot be made out as applied to the amended claims. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103 as unpatentable in view of Buchmann, et al, U.S. Pat. No. 3,820,548 (the "Buchmann reference"). Applicants respectfully traverse the rejection as applied to the amended claims and request reconsideration.

The proper inquiry under § 103 is whether the invention as a whole would have obvious to a person of skill in the art based on the disclosure of the reference. The invention as a whole includes properties and applications of a composition that are disclosed in the application.

The Buchmann reference does not teach or disclose the selection of Ginkgo biloba L. leaves as components of a cigar or cigarette, to result in a tobacco substitute useful in quitting smoking, as disclosed in the current application. The Buchmann reference emphasizes processes for comminuting a mixture of different low-wood parts of at least two different botanicals, instead of focusing on a selection of plants. Such disclosure does not motivate one of skill in the art to select Ginkgo biloba leaves as the burnable material in its tobacco substitute so that the resulting substitute has the property of aiding a smoker in quitting. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness is not made out with respect to the amended claims, and respectfully request that the rejection be withdrawn.

New Method Claims 14-18

New claims 14-18 recite a method for quitting smoking, comprising the step of smoking cigarettes containing Ginkgo biloba leaves. Such a method is neither taught nor suggested by any of the art of record. Accordingly, Applicants respectfully request that claims 14-18 be passed to allowability.

CONCLUSION

For the reasons discussed above, Applicants believe that new claims 4-18 are in an allowable condition and respectfully request an early notice of allowance. The Examiner is invited to telephone the undersigned if that would be useful to resolving any issue.

Respectfully submitted,

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